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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,937	01/26/2004	George R. Kaplan	LKI 205.4	9317
7590	09/07/2005		EXAMINER	
Steven M. Hoffberg MILDE & HOFFBERG, LLP SUITE 460 10 BANK STREET WHITE PLAINS, NY 10606			EVANS, GEOFFREY S	
			ART UNIT	PAPER NUMBER
			1725	
DATE MAILED: 09/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/764,937

Applicant(s)

KAPLAN ET AL.

Examiner

Geoffrey S. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 126-149, 151-166, 168-172 and 174-176 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 126-138 and 151-164 is/are allowed.
- 6) ☒ Claim(s) 139-149, 165, 166, 168-172 and 174-176 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The indicated allowability of the claims in the previous advisory action is withdrawn in view of the current interpretation of the references. This delay is regretted. The final rejection is withdrawn. The following rejections are based on the set of claims received 17 August 2005, that have been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 139-149, 165, 169-171, 175 and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenwasser et al. in U.S. Patent No. 5,753,887 in view of Gresser et al. in U.S. Patent No. 4,392,476. Rosenwasser et al. discloses a method of laser marking a gemstone surface with a laser light absorptive coating of ink or dye (see

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column 3, line 65 to column 4, line 4), and forming a permanent mark (engraving) into the surface of the gemstone. Rosenwasser et al. does not disclose marking a line generated based on the output of a mapping system. Gresser et al. teaches using a computer (element 85) to map out a line (see either figure 2 or figure 3) by suitable control of the workpiece position(orientation) and control of laser beam movement (by scanner elements 61 and 63) . Regarding claim 142, Rosenwasser et al. discloses that the gemstone can be a diamond (see column 5, line 19). Regarding claims 144-147, Rosenwasser et al. discloses using the laser beam to engrave a serial number (see column 2, lines 36-40). Since the coating is more absorptive than the diamond, it allows a lower energy to be used to engrave the diamond.

5. Claims 165, 166, 168, 171, 172, 174 and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gresser et al. in U.S. Patent No. 4,392,476 in view of Rosenwasser et al. in U.S. Patent No. 5,753,887. Gresser et al. discloses a method of laser marking a diamond surface by having the laser beam move to successive points on the surface with a predetermined pattern (e.g. see figure 3). Gresser et al. also discloses the user entering the pattern (indicia ; see column 3, lines 35-42) and using a computer (element 85) to map out a line (see either figure 2 or figure 3) by suitable control of the workpiece position(orientation) and control of laser beam movement (by scanner elements 61 and 63). Gresser et al. does not disclose coating the diamond surface with a material that is capable of interacting with a laser beam. Rosenwasser et al. teaches using a light absorptive coating to prevent internal damage to the diamond. It would have been obvious to adapt Gresser et al. in view of

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Rosenwasser et al. to provide this to prevent internal damage to the diamond and so that a less powerful laser beam can be used to engrave the diamond. Regarding claim 176, the inscription is arbitrarily determined by the user's programming of the computer and not limited by a mask pattern.

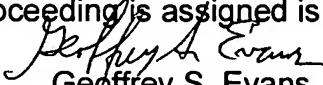
6. Claim 175 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gresser et al. in view of Rosenwasser et al. as applied to claim 171 above, and further in view of Winston et al. in U.S. Patent No. 5,149,938. Winston et al. teaches laser marking an identification code on a diamond (see column 1, lines 20-30 and column 2, lines 28-38). It would have been obvious to adapt Gresser et al. in view of Rosenwasser et al. and Winston et al. to provide this so that the identity of the diamond can be uniquely determined.

7. Claims 126-138 and 151-164 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

GSE

  
Geoffrey S. Evans  
Primary Examiner  
Group 1700